

Remarks

The Office Action mailed May 18, 2006 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-31 are now pending in this application, of which claims 1 and 16 have been amended. Claims 22-31 are withdrawn from prosecution as being directed to a non-elected invention. It is respectfully submitted that the pending claims define allowable subject matter.

A. The Restriction Requirement

Applicants request reconsideration of the Restriction Requirement in light of the following remarks.

A restriction to either the invention of Group I, consisting of claims 1-21, drawn to a dual use package as classified in class 206; and the invention of Group II, consisting of claims 22-31, drawn to a method of using the package as classified in class 493, was imposed. In response, Applicants confirm the election, with traverse, to prosecute the invention of Group I, claims 1-21. The election is made with traverse for at least the following reasons.

The Office Action states that the product as claimed in Group I can be used in a materially different process to that of Group II, such as storing. It is not evident, however, how this relates to the claims at issue. Claim 23, for example, recites a method step of packaging footwear in a lunchbox. The apparent implication of this claim is that the lunchbox is uniquely suitable for storing lunch items or food items *as well as* storing footwear items. As another example, claim 25 recites the step of “providing a dual-use container having a storage cavity.” Thus, the method claims of Group II clearly contemplate storage and storage use, and without perhaps some delineation of what is being stored, the assertion in the Office Action that the product as claimed can be used in a materially different process such as storing is clearly incorrect. Storing is *not* a materially different use of the product apart from what is claimed.

Also, the inventions of Group I and Group II are clearly related, and Applicants disagree that the claim groups pertain to recognized divergent subject matter. Considering the similarities

in the language used in the claims and the overlapping concepts between the identified claim Groups, it is not evident how or why the present election requirement in any simplifies, aids or advances the prosecution of the present application. A thorough search of either of the identified Groups would apparently encompass the other one, and it is not clear that simultaneous examination of all of the claims would present an undue burden on the Examiner.

Because requirements for election are not mandatory under 35 U.S.C. 121, Applicants accordingly request reconsideration and withdrawal of the election requirement.

B. The Objection to the Drawings

The objection to the drawings is respectfully traversed.

Applicants note that Figure 5 illustrates the expandable section recited in claim 9 and described in at least paragraphs [0040] through [0045] of the specification.

Paragraph [0035] has been amended to include the inadvertently omitted reference number "52" identified in the Office Action.

Applicants accordingly request that the objection to the drawings be withdrawn.

C. The 112 Rejection

The rejection of claim 16 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Claim 16 has been amended to overcome the issue noted in the Office Action, and Applicants accordingly request that the rejection of claim 16 be withdrawn.

D. Prior Art Rejections

The rejection of claims 1-21 under 35 U.S.C. § 102(b) as being anticipated by Davis (U.S. Patent No. 4,334,601) is respectfully traversed.

Applicants note the following with respect to the applicable law of anticipation. As explained by the Federal Circuit, a Section 102(b) rejection on the ground of "anticipation" requires a disclosure in a single piece of prior art of each and every limitation of a claimed

invention. A finding of anticipation requires that the publication describe all of the elements of the claims arranged as in the patented device. In other words, to anticipate, a single reference must teach every limitation of the claimed invention.

Col 4., lines 9-16 are cited in the Office Action as teaching certain aspects of the claimed invention. Applicants disagree that Davis discloses the present invention.

Davis discloses a multiple compartment utility bag having three compartments serving different purposes. As noted by Davis at col. 4., lines 9-16, the utility bag includes a central compartment B for carrying soft drinks, an extensible end compartment A for holding soccer balls and athletic equipment, and a second end compartment C for holding smaller and foldable items such as clothing, towels, etc.

Claim 1 recites a “dual-use product package comprising a non-food product; a non-rigid base defining a cavity holding said non-food product, said cavity being adapted to contain food products once the non-food product is removed from said cavity; a cover configured to close said cavity; and a closure member fastening said cover to said base.”

Notably, Davis et al. nowhere disclose the utility bag as a “product package”. That is, none of the compartments A, B and C of the Davis bag are described as packaging any of the associated produces (soccer balls, athletic equipment, soft drinks, clothing and towels) for sale in the bag. Presumably, then, the utility bag, like many types of bags, is purchased separate and apart from the items to be carried in it. The Davis bag is therefore not properly characterized as a “product package” as the term is used in the specification and claims of the present application.

Still further, Davis nowhere describes the compartment B being used in connection with non-food products as claim 1 clearly recites. Rather, only compartments A and C are described for containing non-food products. Similarly, neither of the compartments A or C or described in connection with food items, but rather only non-food items. None of the compartments A, B and C are described are described in connection with both food and non-food products as claim 1 recites.

Applicants traverse the notion that Davis teaches a non-rigid base. Applicants note that compartment B of the Davis bag is an insulated compartment having polyurethane foam in the interior walls thereof, and the compartment B is disclosed in conjunction with beverage cans. While Davis is silent regarding whether the compartment walls are rigid or non-rigid, considering that the compartment B is intended for soft drink beverage cans it is likely that the compartment walls of Davis are relatively rigid to handle the weight and structural load of multiple beverage cans. From the standpoint of a user carrying the bag, a non-rigid compartment, particularly in the bottom or base portion of the compartment, would be undesirable for carrying full beverage cans. The bag would be difficult to carry unless the compartment B was relatively rigid, and the cans would be subject to a good deal of jostling and impact as the bag was handled if the compartment B was non-rigid.

For at least the reasons set forth above, claim 1 is not anticipated by Davis. Also, because Davis does not suggest the dual-use product package of claim 1, claim 1 is submitted to be patentable over Davis.

Claims 2-12 depend from claim 1, and when the dependent claims 2-12 are considered in combination with claim 1, claims 2-12 are likewise submitted to be patentable over Davis.

Moreover, the recitations of claim 7, 8 and 10 are nowhere disclosed or suggested by Davis. Footwear is nowhere disclosed by Davis, and a product package including a non-food item of footwear as recited in claim 8 is not obvious over Davis. Likewise, the Davis bag is rather large and bulky for use as a lunchbox, and because Davis nowhere describes food items in connection with the bag, claims 8 and 10 are not believed to be obvious over Davis.

Claim 13 recites a “footwear package comprising: a support surface; a plurality of soft side walls extending from said support surface and defining a cavity for holding footwear above said support surface, wherein at least one of said side walls comprises a flap folded over the remaining side walls to define a cover over said cavity; and a zipper selectively coupling and uncoupling said flap and said remaining side walls.”

As noted above, Davis nowhere discloses anything being “packaged” in the utility bag within the meaning of the presently claimed invention, much less does Davis disclose footwear being packaged in the bag. Footwear is nowhere mentioned in the Davis disclosure, and the assertion in the Office Action that the Davis bag is capable of holding footwear does not make the Davis utility bag a footwear package within the meaning of the present application. The embodiments of the bags illustrated in the drawings of Davis are not well suited for packing of footwear either, as shape of the insulated compartment B is not shaped to be compatible with footwear in an efficient manner from a packaging standpoint.

Additionally, and as noted in paragraphs [0004] to [0006] of the present specification, footwear has conventionally been packaged in relatively rigid cardboard boxes that are disadvantaged in a number of aspects. Davis neither recognizes nor resolves such problems, and does not render the present invention obvious.

Claim 13 is therefore submitted to be patentable over Davis.

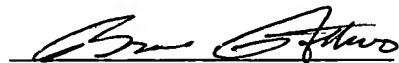
Claims 14-21 depend from claim 13, and when the dependent claims 14-21 are considered in combination with claim 13, claims 14-21 are likewise submitted to be patentable over Davis.

Applicants therefore respectfully request that the Section 102 rejection of claims 1-21 be withdrawn.

Regarding the method claims 23-31, the recitations of these claims are likewise neither disclosed or suggested by Davis, and the method claims are respectfully submitted to be patentable over Davis for similar reasons to the product claims 1-21.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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